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In re Application of:
Weiss, Joel et al
Application Serial No.: 10/734,377
Filed: December 12, 2003
For: **MINIMIZED SKEW ANGLE SLIDER**

**DECISION
ON PETITION**

This is a decision on the petition to vacate the final Office action filed August 22, 2008, pursuant to 37 CFR § 1.181 and also on the petition to withdraw an outstanding restriction requirement filed July 28, 2008, pursuant to 37 CFR § 1.144.

Background

A restriction requirement was mailed on August 7, 2006 setting forth 14 different independent or distinct species with claims 1, 2 and 24-28 identified as generic.

An interview summary between the examiner and the attorney of record was conducted on September 6, 2006. A general discussion of the election of species requirement was discussed.

A response to the restriction requirement was timely filed and received in the Office on September 11, 2006 (including Certificate of Mailing dated September 7, 2006), where applicants elected to prosecute species 8, as identified in the restriction requirement as corresponding to figure 13, with traverse. Applicants identified claims 3-12 and 30-32 clearly readable on figure 13, but argued that claims 13-23, 29 and 33-40 were addressed to the same inventive concept as species 8 and were plainly and eminently compatible with the explicit depiction of species 8 in figure 13, and were therefore readable on species 8. Also, applicants argued that all claims 1-40 be examined together since these claims overlapped in scope, and search and examination could be made without serious burden.

A non-final Office action was mailed on November 22, 2006, where the Office action acknowledged the election with traverse of the species of figure 13 including claims 1-12, 24-28 and 30-32 to read thereon and addressed the attorney's arguments. The examiner addressed that the species of elected figure 13 clearly limited to the features of air bearing surface. The claims did not have overlapping scope since all sliders were associated with some suspension, and conversely, all suspensions were associated with some sliders. Furthermore, clearly there was a serious burden on the examiner with 14 different species. Claims 13-23, 29 and 33-40 were being withdrawn from further consideration to 37 CFR 1.142(b) as being drawn to non-elected species. The Office action also indicated the prior restriction requirement was made final.

A response to the non-final Office action was filed and received on April 26, 2006, where applicants acknowledged the restriction requirement being made Final.

A final Office action was mailed on July 27, 2007; then applicants followed with a request for continued examination filed September 26, 2007 including an amendment to generic claims 1, 27 and 28.

A non-final Office action was mailed December 4, 2007 addressing the merit of the newly amended claims 1, 27 and 28 along with claims 2-12, 24-26 and 30-32 and indicating claims 13-23, 29 and 33-40 were withdrawn from consideration.

A response to the non-final Office action was filed on March 4, 2008 including further amendment to generic claims 1 and 27.

A final Office action was mailed May 28, 2008, where the Office action stated the newly amended claims 1 and 27 are directed to the non-elected species. The Office action further stated the amended phrase as set forth in the amended claims 1 and 27 were withdrawn from consideration as being directed to a non-elected invention.

Petitioner seeks relief by filing a petition under 37 CFR §1.144 on July 28, 2008 requesting that the restriction requirement be withdrawn, then followed with a petition under 37 CFR § 1.181 on August 22, 2008 requesting to vacate the final Office action.

Opinion

Petitioner contends that the restriction requirement made in the August 7, 2008 Office action was improper, for at least the reason that the restriction had improperly identified figures 9 and 10 as separate independent or distinct species 4 and 5, where these figures were merely a top plan view and a side plan side of the same embodiment, showing the same features. Thus, these species were not independent or distinct inventions as set forth in MPEP 800. Petitioner also contends that the final rejection was premature in that the claim amendment filed March 4, 2008 did not constitute a shifting to non-elected subject matter.

A review of the record finds that applicants have persuasively argued the restriction requirement failed to show different distinct species as set forth in MPEP 800.

For the above stated reasons, the petition to withdraw the restriction requirement is **GRANTED**. Thus, the restriction requirement is hereby withdrawn.

Accordingly, the petition to vacate the final Office action mailed May 28, 2008 is also **GRANTED** in view of the withdrawn of the restriction requirement. The final Office action mailed May 28, 2008 is hereby vacated.

The application file is being forwarded to the examiner for preparation of a new and appropriate action, including a revised restriction requirement if improper, in due course.



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